

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1923.

No. _____

CONCRETE APPLIANCES COMPANY AND WILLIAM H. INSLEY,
Petitioners,
vs.

JOHN E. GOMERY, JOHN C. SCHWARTZ, MICHAEL J. O'MEARA AND
CONCRETE CONSTRUCTION COMPANY,
Respondents.

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION AND
BRIEF FOR WRIT OF CERTIORARI TO THE COURT OF
APPEALS FOR THE THIRD CIRCUIT.

There is no real conflict between the decisions of the Third Circuit Court of Appeals and of the Sixth Circuit Court of Appeals, and, therefore, there is no proper basis for a writ of certiorari.

It is true that the Sixth Circuit Court of Appeals, in January, 1920, held that the claims in question were valid, on the *very meager record* before it at that time. It is also true that the Third Circuit Court of Appeals

held these same claims invalid in July, 1923, in view of the very lengthy and *detailed history of the practical development of the art* then before it. However, the records in the two cases were so different that the issues before the Court in each case were likewise *entirely different*.

This difference was recognized by the Third Circuit Court of Appeals at the time it rendered its opinion and can be emphasized no better than to quote from said opinion.

"Had the actual state of the prior art been shown to the patent authorities we cannot feel they would have granted this patent and while we feel embarrassed to find ourselves at variance with the Circuit Court of Appeals of the Sixth Circuit, which in the case of Concrete Appliances Co. et al., v. Meinken et al., 262 Fed., 958, found this patent valid, we feel assured that the meager record before that court wholly failed to disclose the uncontradicted proofs on which we base our conclusions."

The Cincinnati Court had before it only a "paper" showing consisting of a few patents with no testimony whatever as to the practical development of the art or of prior uses.

The Philadelphia Court had before it a complete history of the practical development of the art reinforced by over sixty exhibits, other than patents.

The defendants, in the earlier case, in the Sixth Circuit Court had only one witness, Wm. H. Insley, who was one of the *plaintiffs* in that suit and in the present suit. Defendant's entire proofs will be found in the three and one-half pages, beginning with page 32 of the Court of Appeals' Record in the Cincinnati case.

The defendants, in the later case, in the Third Circuit Court had over fifty witnesses. The testimony of forty of these witnesses was taken by depositions, the testi-

mony of ten was stipulated and two were called in open court.

The Callahan patent in suit, No. 948,719, issued February 8th, 1910, on an application filed January 21st, 1909. The District Court in Cincinnati held the claims invalid, on the record before it. The Court of Appeals held said claims valid.

The District Court in Philadelphia held the claims valid but not infringed, intimating, however, that on the record before it said claims would have been held invalid but for said earlier decision of the Sixth Circuit Court of Appeals, which said District Court felt bound to follow. The Third Circuit Court of Appeals held the same claims invalid in view of the new showing presented.

In the Third Circuit, many prior uses were proved of apparatus so analogous to that of the patent in suit as to present an entirely different basis for determining the question of invention, entirely aside from the question of novelty. There was also presented testimony and photographs clearly establishing the prior use in St. Louis in 1908 of the exact combination of elements claimed. Such a showing is in strong contrast to the record in Cincinnati which was entirely devoid of prior uses. In fact, anticipation was not even alleged, much less proved. The Court in that circuit held:

"It is not contended that the patent is anticipated, in the strict sense of that term. . . ."

The Court also held that certain of the main defenses

"entirely lack the only substantial novelty claimed for Callahan."

This lack was abundantly supplied in the Philadelphia case.

The Court also said:

"On the other hand, it impresses us as a bold

and original thought that this material could be handled in this way. Distributing mush concrete through gravity chutes by one apparatus throughout the whole course of building obviously involved difficulties; it had **never been handled by gravity chutes at all** excepting under simple conditions where these difficulties did not exist,—and then, perhaps, had been done **only on paper;**”

Further:

“The quasi-automatic elevation and distribution of wet concrete under the varying conditions of progressive building and by a single apparatus was **an entire novelty**. No one had tried to do it; apparently, **no one had thought of it**; it was useful in a very high degree; and when we find a new result in this complete and extreme sense accomplished by a confessedly new combination,—though of known means,—we think both the purpose of the patent law and the rightful application of the decisions thereunder require that it should be awarded the merit of invention.” (Emphasis ours.)

The record before the Philadelphia Court was replete with instances wherein mush concrete had been handled in this way not only *on paper* but as an *actual fact*. Where the meager record before the Court in Cincinnati justified the inference that Callahan’s handling of material this way was “a bold and original thought,” the record before the Court in Philadelphia showed that so much had been known by others and so much had been practiced by others in this same field that Callahan’s alleged invention was no advance in the art at all and that his making application for a patent was due to his unfamiliarity with practices which, in many quarters, were matters of common knowledge. This situation is forcefully expressed by the Third Circuit Court of Appeals in the following words:

“Comparison of Callahan’s apparatus with the prior art shows that it really constituted **no ad-**

vance over that art, but on the contrary, rather a step backward. For example, he either had **no knowledge of the use of the open trough or chute**, or if he had made no mention of it or suggestion of its possible use, confining his specification and limiting his claims to 'a conduit' or closed pipe. And the proof is that this closed conduit of his claim soon proved worthless on account of clogging and had to be supplanted by the open chute of the earlier art." (Emphasis ours.)

There was no proof before the Court of Appeals of the Sixth Circuit as to the actual early work of Callahan, or as to the actual practical work of anyone else, as previously stated, whereas the opinion just quoted was based on a full showing of Callahan's early work in California, which was before the Third Circuit Court of Appeals.

The record before the Third Circuit Court of Appeals comprises nearly a thousand printed pages of testimony relating to the early use of apparatus for distributing mush concrete and illustrating the development of the art up to and somewhat beyond the date of the patent in suit February 8th, 1910. The outstanding structures and developments are as follows:

The Ingalls Building, built in 1902, in Cincinnati. (Also illustrated in the Engineering News of January 30, 1903.)

The Lynnhaven Hotel, built in Norfolk, Va., in 1906.

American Theatre Building, St. Louis, 1907.

Coliseum Building, St. Louis, 1908.

Tootle-Campbell Building, St. Joseph, Missouri, 1908.

Sumner High School, St. Louis, 1908.

Franklin School, St. Louis, 1909.

Operations of Healy-Tibbets Co. in San Francis-

co, for a period of several years following the earthquake and fire in 1906, in the rebuilding of docks and piers along the water front.

Majestic Theatre Building, Los Angeles, 1908.

Operations of the Great Lakes Dredge and Dock Co. in connection with the building of the plant of the U. S. Steel Co. at Gary, Indiana, beginning in 1906, and covering a period of years.

Construction of various grain elevators in different parts of the country, including Portland, Maine, and New Orleans, at least as early as 1905.

Testimony of several engineers regarding early use of grain spouting equipment, apparatus similar to which was used later for spouting concrete.

Testimony regarding construction of Webber Dam, Lyons, Michigan, in 1906, showing actual use of grain spouting apparatus for distributing mush concrete, showing the tying together of the grain distributing art and the concrete distributing art, long prior to the patent in suit.

Testimony to show that the most important of the St. Louis uses were admittedly well known to the plaintiffs at the time of the Cincinnati suit, but were apparently unknown to the defendants in that suit, or in any case, were not brought into the record, as that they were not before that Court. They were presented for the first time to the Third Circuit Court of Appeals.

Track elevation work in Chicago beginning in 1903, involving concrete distributing apparatus employing a swinging boom.

Prior publications other than patents including various copies of the Engineering News and the Engineering Record prior to the date of the patent in suit; a number of text books; excerpts from the

Transactions of the American Society of Civil Engineers; and certain early catalogues.

Testimony of each of the three parties involved in an interference which included Callahan's application forming the basis of the patent in suit.

The testimony of an engineer regarding building practices in San Francisco developed as a result of the earthquake and fire and its relation to the *natural evolution* in the art which lead to the general adoption of apparatus of the character in suit, independently of any contribution by the patentee, Callahan.

Testimony showing that the apparatus complained of as an infringement in the Third Circuit was materially different from the apparatus complained of in the Sixth Circuit.

Testimony as to lack of public acquiescence.

None of the foregoing defenses was before the Sixth Circuit Court of Appeals in the earlier suit and the contention of the petitioners that the prior uses referred to in the decisions of the Court of Appeals for the Third Circuit were of apparatus "substantially the same as that of the prior patents found in the record in the Sixth Circuit," is inaccurate and misleading, as only a few of the patents in question were related to uses brought out in the later testimony, and in the only instance of importance (the Smith patent, which was also involved in the Cincinnati suit and was held invalid) the date of the patent was *not early enough* to constitute an anticipation of the Callahan patent, whereas the *use* of the apparatus, on which the patent was based, *was early enough* and was proved for the first time in the Philadelphia suit. Many of the other patents related to what might be called "freak" apparatus which, as far as known, never went into general use, whereas most of the testi-

mony in the record in the Third Circuit related directly to actual uses, reinforced by blue-prints, photographs and other data.

The contention that the Court of Appeals for the Third Circuit did not base its decision on the same claim as the Court of Appeals for the Sixth Circuit is only superficially true, as both courts considered all the claims, but selected different ones as convenient illustrations of the principles discussed in their decisions. The Third Circuit Court of Appeals said that claim 1 "is fairly illustrative of the elements of the other three claims." The Sixth Circuit Court of Appeals stated that claim 5 "may be accepted as a statement of his invention said to be infringed."

The statement of petitioners on page 6 of their brief that the prior uses presented for the first time to the Third Circuit Court of Appeals "were not uses of the complete apparatus of the claims" must be challenged, as among such uses is the apparatus employed in building the St. Louis Coliseum in the summer of 1908, a photograph of which, Defendants' Exhibit 22, shows the complete combination of the five elements claimed. On the next page of said brief, petitioners allege that two elements of the combination were lacking in the prior art considered by the Third Circuit Court of Appeals in its discussion of claim 5, viz: the boom carrying a conduit and the vertical adjustability of the bin. Both of these features, however, are clearly shown in the St. Louis Coliseum apparatus and are described by witnesses. Furthermore, on page 10 of said brief, the statement is made "In both Courts the particular entire combination of elements was not found in the prior art." This assertion completely ignores Exhibit 22 and the other undisputed showing made as to the existence and

use of the combination of the same five elements during the erection of the St. Louis Coliseum in the summer of 1908.

By way of summary, the Sixth Circuit Court of Appeals had nothing before it to show that the claims in suit were anticipated, and in view of the "paper" showing made, of material handling apparatus in somewhat different arts, did not feel justified in ruling that the claims in suit did not involve invention, but on the contrary, ruled that the claims were valid. The Third Circuit Court of Appeals at a later date had presented to it a complete anticipation of the combination claimed and a full and complete showing of the entire practical development of the art and of related arts, in view of which latter there is evidently no invention in the combinations claimed, even in the absence of the complete anticipation referred to.

In addition, the Third Circuit Court of Appeals had before it proof that the Callahan invention was *impractical* and *inoperative* and was not made practical and operative until a considerably later date, and not until the defects in the equipment had been overcome by others. Said Third Circuit Court of Appeals therefore concluded that not only were the claims *invalid*, but also that the apparatus of the Callahan patent was a *step backward* in the art. These conclusions having been based on an entirely different presentation of facts from that before the Sixth Circuit Court of Appeals, there is no real conflict in the decisions. The same record, if presented to the Sixth Circuit Court of Appeals or Court of Appeals in any of the other remaining circuits would, as intimated in the decision of the Third Circuit Court of Appeals, compel the same conclusion reached by it.

In view of the foregoing, it is respectfully submitted that the petition for writ of certiorari in this case should be denied.

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